

REMARKS

Claims 1-27 are pending. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Status of the Claims

Claims 15 and 26 were objected to.

Claims 1-16 were rejected pursuant to 35 U.S.C. § 112, first paragraph.

Claims 1-27 were rejected pursuant to 35 U.S.C. § 112, second paragraph.

Claims 1-27 were rejected pursuant to 35 U.S.C. § 101.

Claims 17-27 were rejected pursuant to 35 U.S.C. § 102(b) over Graef (US 2001/0042292).

Claims 17-25 were rejected pursuant to 35 U.S.C. § 102(b) over Sugiura (US 6,186,490).

Claims 1-11 were rejected as obvious pursuant to 35 U.S.C. § 103(a) over Sugiura in view of Boucher (US 6,655,679).

Claim 12 was rejected as obvious pursuant to 35 U.S.C. § 103(a) over Sugiura in view of Boucher and DiBlasio (US 4,4754,365).

Claim 16 was rejected as obvious pursuant to 35 U.S.C. § 103(a) over Sugiura in view of Boucher and DiBlasio and Beskitt (US 6,331,000).

Claims 13-15 were not rejected on prior art, but only rejected under 35 U.S.C. § 101 and 35 U.S.C. § 112. Note MPEP § 706.01. These claims are presumed to be objected to as being dependent upon a rejected base claim but would otherwise be allowable if written in an independent form while overcoming the base claim rejection and the rejections pursuant to 35 U.S.C. § 101 and § 112. The inferred indication of allowable subject matter is appreciated.

Objection to the disclosure

The language "should appear" in 37 CFR 1.77(c) is not a requirement but merely a suggestion for the "preferable" manner of framing a specification, as evidenced by MPEP 608.01(a) (Rev. 3, August 2005, page 600-72, col. 1). Applicants respectfully decline the invitation to amend the section headings.

The typographical errors regarding shaft 248 and tab portion 270 have been corrected. The Examiner's notice thereof is appreciated.

The Drawing objections

One skilled in the art would understand that the reference characters 154 and 164 do not designate the *same* part in Figure 9. The specification is clear that the cam 154 is bounded by a cam surface 164 (e.g., page 22, line 17). This is further evidenced by Figures 7 and 10.

One skilled in the art would understand that the reference characters 94 and 80 do not designate the *same* part in Figure 10. The specification is clear that the picking member 72 has an outer bounding surface 80 (e.g., page 17, line 1; Figures 2-3). The specification is also clear that the picking member 72 has a shaft 88 and three separated cylindrical portions (central portion 90, first outboard portion 92, and second outboard portion 94) are supported on the shaft (e.g., page 19, lines 7-14; Figures 2-3). Figure 10 shows the outer surface of segment 144 moved to generally conform with the outer bounding surface 80 of the picking member 72. Figure 10 also shows outboard portion 94.

Reference character 216 (Figure 18) has support in the specification. For example, note page 28, line 15 and page 29, line 20.

Reference character 277 (Figure 18) has been provided at page 37, line 4. The Examiner's notice of this typographical error is appreciated.

Applicants respectfully traverse the drawing objection pursuant to 37 CFR 1.83(a). First, Applicants respectfully submit that the application includes at least one process claim. Thus, a drawing is neither necessary for an understanding of the invention nor required. Note MPEP § 601.01(f) and MPEP § 608.02. The drawings were filed as a courtesy to the Office. However, Applicants reserve the option of deleting all of the (not required) drawing figures and references thereto. On this basis alone it is recommended that this drawing objection be withdrawn.

Second, Figures 18-20 already show an exemplary embodiment in which a middle disk low friction portion (258) extends radially outward beyond a middle disk high friction arcuate segment (228). Nevertheless, to simplify understanding, the reference numeral 258 has also been shown in Figure 18. Accordingly, attached is an amendment to the drawings. Applicants respectfully submit that the drawing objections should be withdrawn.

The claim objections

The typographical errors in claims 15 and 26 were corrected as requested by the Office. The Examiner's notice thereof is appreciated.

The 35 U.S.C. § 112, first paragraph rejections

Claims 1-16 were rejected pursuant to 35 U.S.C. § 112, first paragraph.

The Applicants respectfully disagree with the rejections. The "specification" referred to in 35 U.S.C. § 112, first paragraph, comprises the entire disclosure, not just the labeled

specification portion of the disclosure. The originally filed claims are part of the original disclosure. A "rejection of an original claim for lack of written description should be rare". MPEP § 2163.03.

The Office has not met its initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims. Note MPEP § 2163 (IA). The Office has done nothing more than argue lack of literal support. However, the invention claimed does not have to be described in *ipsis verbis* in order to satisfy the description requirement of 35 U.S.C. § 112. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

The Action also procedurally fails to establish a lack of written description. In light of the 35 U.S.C. § 103(a) rejections, how can the Office on one hand allege that the recited invention is not described yet on the other hand allege the same recited invention to be obvious, especially when possession of what is described carries with it possession of that which would have been obvious? MPEP § 715.02.

Nevertheless, support for the referenced claim language can be found in the Application. For example, note page 29, lines 5-12; page 32, lines 11-18; and page 34, lines 5-15.

The 35 U.S.C. § 112, second paragraph rejections

Claims 1-27 were rejected pursuant to 35 U.S.C. § 112, second paragraph.

The Applicants respectfully disagree with the rejections. The rejection is unclear. The claims are method claims. The Office objects to "apparatus limitations" yet recommends reciting these same "apparatus limitations". Claim 1 already has a step directed to a picking member, a

middle disk portion, and a first outboard disk portion. Therefore, why the Office recommended an additional (unnecessary) step directed to "providing" a picking member, a middle disk portion, and a first outboard disk portion is unclear.

The 35 U.S.C. § 101 rejections

Claims 1-27 were rejected pursuant to 35 U.S.C. § 101.

The Applicants respectfully disagree with the rejections. The claims are method claims. For example, claim 1 recites positive active steps, such as engaging an end note and rotating a picking member. It is unclear how the claims can be construed as apparatus claims. Note "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility", 1300 Off. Gaz. Pat. Office 142 (Nov. 22, 2005).

The 35 U.S.C. § 102(b) rejections

Claims 17-27 were rejected pursuant to 35 U.S.C. § 102(b) over Graef.

Claims 17-25 were rejected pursuant to 35 U.S.C. § 102(b) over Sugiura.

Claim 17

The Action alleges that Graef teaches a projecting surface (118) and high friction picker surface (116). However, how is the alleged projecting surface (118) radially outward of the alleged high friction picker surface (116)? Nor does Graef teach a projecting surface that is disposed from, axially adjacent to, radially adjacent to, and radially outward of a high friction picker surface in the manner recited. Graef does not anticipate claim 17.

The Action alleges that Sugiura teaches a high friction picker surface (22). The Action is

silent as to what specific element (and its corresponding reference numeral) in Sugiura constitutes the recited projecting surface. Nevertheless, Sugiura does not teach a projecting surface that is disposed from, axially adjacent to, radially adjacent to, and radially outward of a high friction picker surface in the manner recited. Furthermore, the Action admits (at page 13, lines 16-18) that Sugiura does not teach a projection surface radially outward of a high friction picker surface. Sugiura does not anticipate claim 17.

The 35 U.S.C. § 103(a) rejections

Claims 1-11 were rejected as obvious pursuant to 35 U.S.C. § 103(a) over Sugiura in view of Boucher (US 6,655,679).

Claim 1

The Action admits (at page 13, lines 16-18) that Sugiura does not teach a low friction projection portion radially outward of a high friction picker segment. However, Sugiura lacks more of the recited features than the Office admits. For example, where does Sugiura teach or suggest that in a first rotational position, an end note is engaged with *both* a high friction arcuate segment and a low friction arcuate projecting portion, where *both* the high friction segment and the low friction portion are in supporting connection with the same middle disk portion?

Boucher is non analogous art. Boucher is directed to a copying device. Boucher is not directed to engaging an end note bounding a stack of notes in an automated banking machine. One skilled in the art would not have used Boucher's copying device in an automated banking machine to engage notes. Nor is there any evidence that Boucher could properly function with notes. Regardless, copying of notes (counterfeiting) would be illegal and not a valid motivation for modification.

Boucher (like Sugiura) also does not teach or suggest that in a first rotational position, an end note is engaged with *both* a high friction arcuate segment and a low friction arcuate projecting portion. Also, Boucher does not teach a low friction projection portion radially outward of a high friction picker segment. Conversely, in Boucher the rubber section (32) is outward of the friction decreasing surface (36), as evidenced in Figure 4. Boucher cannot alleviate the admitted and further noted deficiencies of Sugiura.

The Office has not established a *prima facie* showing of obviousness. The references, taken alone or in combination, do not teach or suggest all of the recited features, relationships, and steps. Nor would it have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention.

Independent claims 13 and 25

Claims 13 and 25 include subject matter from claims 1, 17, and 20. For reasons already discussed, the references, taken alone or in combination, also do not teach or suggest all of the features, relationships, and steps in these claims.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The Applicants have shown the independent claims to be allowable. Thus, it is asserted that the dependent claims are allowable on the same basis. Furthermore, each dependent claim additionally recites specific features and relationships that further patentably distinguish the claimed invention over the applied art.

The references do not teach or suggest the features and relationships that are specifically recited in these claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

Fee For Extra Independent Claim

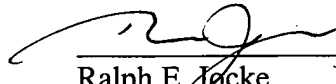
Please charge the fee (\$200) associated with the submission of one independent claim in excess of three, and any other fee due, to Deposit Account 09-0428.

Conclusion

Applicants respectfully submit that this application is in condition for allowance.

The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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